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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRADLEY S. HOYL, CARL G. HARRISON, and
MAURICE ROBERTSON

Appeal 2008-5180
Application 09/812,247
Technology Center 3600

Decided: January 13, 2009

Before WILLIAM F. PATE, III, JOHN C. KERINS, and
STEFAN STAICOVICI *Administrative Patent Judges.*

STAICOVICI, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Bradley S. Hoyl et al. (Appellants) appeal under 35 U.S.C. § 134 from
the Examiner's decision rejecting claims 1-6, 11-16, 20-23, and 31-37.

Claims 7-10, 17-19, 24-30, and 38 have been canceled. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

THE INVENTION

The Appellants' invention is drawn towards a device and a method for supporting cables using a hook and loop type releasable engagement (Spec. 2, ll. 9-10). The device includes a frame 506, a substrate 502 coupled to the frame 506, and a cable fastener 504 that is capable of releasable engagement with the substrate 502 using a "hook and loop" mechanism (Spec. 6, ll. 21-23 and 31-32; Spec. 7, ll. 8 and 25-29; and fig. 5).

Claim 1 is representative of the claimed invention and reads as follows:

1. An apparatus comprising:

a rigid frame, wherein the rigid frame comprises at least one substantially planar surface;

a substrate having a first surface and a second surface substantially opposite the first surface, wherein the first surface of the substrate comprises a first plurality of fasteners of one of a plurality of hook and loop mechanisms and the second surface of the substrate is coupled to the substantially planar surface of the rigid frame; and

a cable fastener comprising a second plurality of fasteners of the one of the plurality of hook and loop mechanisms that covers at least all of one side of the cable fastener, wherein the second plurality of fasteners is configured to engage the first plurality of fasteners, the cable fastener is completely detachable

from the substrate, and the second plurality of fasteners is configured not to engage any portion of the cable fastener,

wherein the cable fastener is further shaped to define:

a variable-width opening,

an elongated body having a predetermined width,

a head portion at one end of the body, the head portion having a width greater than the predetermined width and having a size substantially similar to a size of the variable-width opening, the head defining an opening through which the elongated body of the cable fastener may pass.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Delk	US 5,292,312	Mar. 8, 1994 ¹
Delk	US 5,300,037	Apr. 5, 1994 ²
Lutz	US 5,666,265	Sep. 9, 1997

The following rejections are before us for review:

The Examiner rejected claims 1-6, 11-16, 20-23, and 31-37 under 35 U.S.C. § 103(a) as unpatentable over Lutz in view of Delk '312 and further in view of Delk '037.

¹ Hereafter Delk '312.

² Hereafter Delk '037.

The Examiner rejected claims 1-6, 11-16, 20-23, and 31-37 under 35 U.S.C. § 103(a) as unpatentable over Lutz in view of Delk '037.

THE ISSUE

Have the Appellants shown that the Examiner erred in combining the teachings of Lutz, Delk '312, and Delk '037 or Lutz and Delk '037 to arrive at the claimed invention? The issues turn on whether one of ordinary skill in the art would have found it obvious to combine the teachings of Lutz, Delk '312, and Delk '037 or Lutz and Delk '037 to arrive at an apparatus including a cable fastener having means for releasable engagement (*i.e.*, hook and loop) to a substrate such that, (1) the means for releasable engagement is configured to not engage with any portion of the cable fastener, and (2) is "completely detachable" from the substrate.

SUMMARY OF DECISION

We REVERSE and ENTER NEW GROUNDS OF REJECTION PURSUANT TO OUR AUTHORITY UNDER 37 C.F.R. § 41.50(b).

FINDINGS OF FACT

The following enumerated findings of facts (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 848 F. 2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Lutz discloses a Velcro® cord wrapping system 280 for securing a plurality of cables and cords 507 using a Velcro® patch 281 and an elongate Velcro® strip 282 (col. 8, ll. 43-48 and fig. 7a).

2. Lutz further discloses that the elongate Velcro® strip 282 includes female Velcro® surface 283 on one side and male Velcro® surface 284 on the other side (col. 8, ll. 51-53 and fig. 7a).
3. Figure 7b of Lutz is reproduced below.

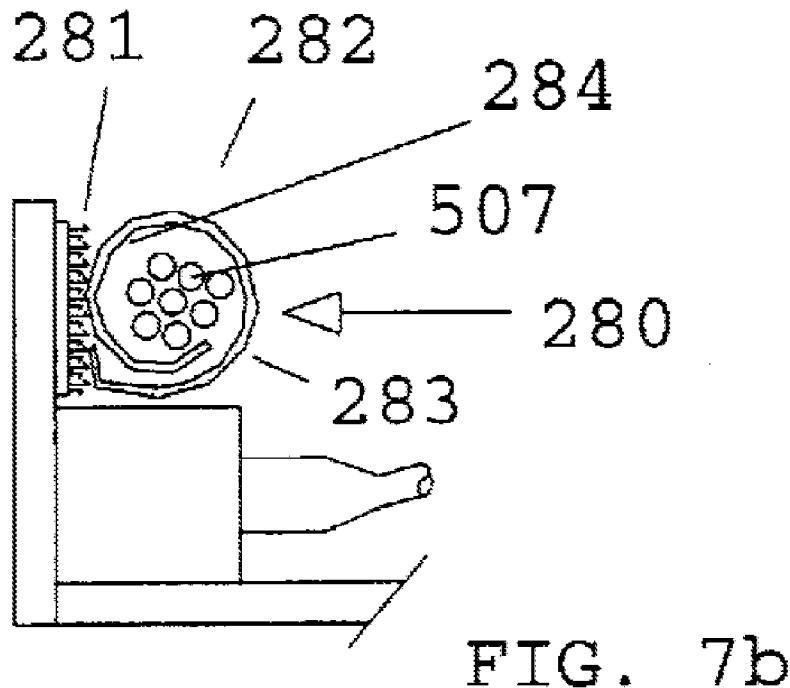


Figure 7b of Lutz depicts the Velcro® cord wrapping system 280 when in use.

4. The elongate strip 282 of Lutz is wrapped around the cables 507 and back onto itself with the female Velcro® surface 283 on the outside, such that a portion is formed where the inside male Velcro® surface 284 becomes attached to the outside female Velcro® surface 283 (col. 8, ll. 53-55 and fig. 7b).
5. The wrapped bundle is attached to the male Velcro® patch 281 (col. 8, ll. 55-57 and fig. 7b).

6. Delk '312 discloses a tube holder 10 for medical tubing, fluid tubing, electronic wiring, or fiber optics including a strap portion 30 (cable fastener) and a base plate 20 (substrate) (col. 5, ll. 51-56; col. 6, ll. 3-4; fig. 1).
7. The top surface of the strap portion 30 (cable fastener) includes smooth outer regions 31 and 33 and a high friction central region 35 (col. 7, ll. 13-15 and 19-21 and fig. 5).
8. The bottom surface of the strap portion 30 (cable fastener) includes hook type Velcro® outer regions 32 and 34 and a central, smooth region 36 (col. 7, ll. 15-17 and 22-24 and fig. 6).
9. The purpose of the central, smooth portion 36 is to eliminate unwanted snagging on other objects in the environment (col. 7, ll. 60-63).
10. Delk '037 discloses a holder 10 for medical tubing, fluid tubing, electronic wiring, or fiber optics (col. 6, ll. 40-45 and fig. 1).
11. Delk '037 discloses a cable fastener including a strap portion 30 (cable fastener) ultrasonically bonded to a base plate 20 (substrate) (col. 6, ll. 60-61; col. 8, ll. 30-33; and figs. 1 and 5).
12. The strap portion 30 of Delk '037 includes a plurality of fasteners (hook type) on a first side 41 and a smooth backing 43 on the opposite, second side 43 (col. 8, ll. 3-7 and 14-15 and figs. 3 and 4).
13. The strap portion 30 of Delk '037 further includes a wide end 33 and a narrow end 34 (col. 7, ll. 63-64 and figs. 3 and 4).

PRINCIPLES OF LAW

Indefiniteness

A specification must conclude with claims "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, ¶ 2 (2000). The essence of the requirement under 35 U.S.C. § 112, second paragraph, that the claims must be definite, is that the language of the claims must make it clear what subject matter the claims encompass. *In re Hammack*, 427 F.2d 1378 (CCPA 1970).

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, e.g., competitors of the patent owner, can determine whether or not they infringe. *All Dental Prodx, LLC v. Advantage Dental Prods'*, 309 F.3d 774, 779-80 (Fed. Cir. 2002)

Obviousness

It is elementary that to support an obviousness rejection all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such

that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

The Examiner has the initial burden of showing a *prima facie* case of obviousness, and the Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("[t]o reject claims in an application under section 103, an examiner must show an unrebutted *prima facie* case of obviousness On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Teaching Away

Where the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, the proposed modification would not have been obvious. *See Tec Air Inc. v. Denso Mfg.*

Michigan Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999); *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). "A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

OPINION

The obviousness rejection based on Lutz, Delk '312, and Delk '037

Lutz discloses a Velcro® cord wrapping system 280 for securing a plurality of cables and cords 507 using a Velcro® patch 281 and an elongate Velcro® strip 282 (FF 1). However, according to the Examiner, Lutz does not disclose a cable fastener having a head portion with "a width greater than a predetermined width" (And. 6). The Examiner determines that it would have been obvious for a person of ordinary skill in the art to have modified Lutz by providing the cable fastener of Delk '312 as a substitute for the fastener of Lutz because both Lutz and Delk '312 teach cable fasteners for holding cables/tubular members to substrates (Ans. 6). However, the Examiner further notes that Lutz in view of Delk '312 does not teach that the hook and loop mechanism covers "at least all of one side of the cable fastener" (Ans. 6). The Examiner then employs the teachings of Delk '037 to show that it would have been obvious for a person of ordinary skill in the art to have modified Lutz in view of Delk '312 by providing the cable fastener of Delk '037 in order to provide a fastener that can hold a variety of cable sizes (Ans. 7).

We disagree with the Examiner's position, because modifying the cable fastener of Lutz in view of Delk '312 to provide a hook and loop mechanism that covers "at least all of one side of the cable fastener," as taught by Delk '037, is contrary to the specific teachings of Delk '312. That is, Delk '312 specifically teaches a tube holder (cable fastener) having a first surface including a central, smooth portion 36 located between hook type Velcro® outer regions 32 and 34 (FF 8). Hence, the hook and loop mechanism of the fastener of Delk '312 does not cover "at least all of one side of the cable fastener," as required by the Appellants' claimed invention. Moreover, Delk '312 specifically teaches that the purpose of the central smooth portion 36 is to eliminate unwanted snagging of the fastener on other objects in the environment (FF 9). In contrast to the teachings of Delk '312, Delk '037 discloses a tube holder (cable fastener) having a plurality of fasteners (hook type) on a first side 41 and a smooth backing 43 on the opposite (FF 10 and 12). Hence, Delk '312 specifically teaches away from the combination of Lutz, Delk '312, and Delk '037, because although the hook and loop mechanism of the fastener formed by the combined teachings of Lutz, Delk '312, and Delk '037 covers "at least all of one side of the cable fastener," the fastener would be prone to snagging on other objects in the environment, which is in contrast to the purpose and mode of operation of the fastener of Delk '312. Therefore, we find that a person of ordinary skill in the art would not have combined the teachings of Lutz, Delk '312, and Delk '037 as proposed by the Examiner. To do so would render the cable fastener of Lutz in view of Delk '312, as modified by Delk '037, unsatisfactory for its intended purpose. In conclusion, we find that the modification proposed by the Examiner as evidenced by the combined

teachings of Lutz, Delk '312, and Delk '037 would not have been obvious to the person of ordinary skill in the art.

The obviousness rejection based on Lutz and Delk '037

The Appellants argue that the combination of Lutz and Delk '037 does not teach a cable fastener having means for releasable engagement with a substrate, *i.e.*, hook and loop mechanism, such that the means for releasable engagement is (1) configured not to engage with any portion of the cable fastener and (2) is “completely detachable” from the substrate (App. Br. 12).

Lutz discloses a Velcro® cord wrapping system 280 for securing a plurality of cables and cords 507 using a Velcro® patch 281 and an elongate Velcro® strip 282 (FF 1). Lutz further discloses that the elongate Velcro® strip 282 includes female Velcro® surface 283 on one side and male Velcro® surface 284 on the other side (FF 2). When in use, the elongate strip 282 is wrapped upon itself such that a portion is formed where the inside male Velcro® surface 284 becomes attached to the outside female Velcro® surface 283 (FF 3 and 4). In contrast to the Appellants’ claimed invention, the means for releasable engagement (hooks and loops) in Lutz is configured to engage with a portion of the cable fastener. Hence, we agree with the Examiner that Lutz does not teach that the means for releasable engagement is configured not to engage with any portion of the cable fastener (Ans. 10). The Examiner asserts that because Delk '037 teaches a strap portion 30 (cable fastener) having a plurality of fasteners (hook type) on a first side 41 and a smooth backing 43 on the opposite, second side 43

(FF 11 and 12), the combination of Lutz and Delk ‘037 teaches that the means for releasable engagement is configured not to engage with any portion of the cable fastener (Ans. 10-11). Finally, the Examiner concludes that it would have been obvious for a person of ordinary skill in the art to have modified Lutz by providing the cable fastener of Delk ‘037 as a substitute for the fastener of Lutz because both Lutz and Delk ‘037 teach cable fasteners for holding cables/tubular members to substrates (Ans. 13).

We disagree with the Examiner’s position for the following reasons. First, we note that the mode of operation of the fastener of Lutz is different than that of the fastener of Delk ‘037. Specifically, the mode of operation of the fastener of Delk ‘037 teaches away from the mode of operation of the fastener of Lutz, hence teaches away from combining the disclosure of Lutz and Delk ‘037, as suggested by the Examiner. Lutz discloses wrapping the elongate strip 282 upon itself to form a bundle and releasably attaching the wrapped bundle to the male Velcro® patch 281 (FF 3). In contrast, Delk ‘037 discloses attaching the tubing C between the ultrasonically bonded strap portion 30 and the base plate 20 (FF 11). As such, because the strap portion 30 (fastener) and the base plate 20 (substrate) of Delk ‘037 are ultrasonically bonded, they are not “completely detachable.” A person of ordinary skill in the art would not have combined the teachings of Lutz and Delk ‘037 because the cable fastener of Lutz and Delk ‘037, as proposed by the Examiner, would not be “completely detachable” from the substrate, as required by the Appellants’ claimed invention. As such, we find that the modification proposed by the Examiner, as evidenced by the combined teachings of Lutz and Delk ‘037, would not have been obvious to the person of ordinary skill in the art.

Second, we note that the Examiner has not provided any factual basis to show that a person of ordinary skill in the art would have readily substituted the Velcro® strip 282 of Lutz with the strap portion 30 of Delk ‘037. Specifically, the Examiner has not identified a reason that would have prompted a person of ordinary skill in the art to modify the Velcro® strip 282 of Lutz such that the male Velcro® surface 284 of Lutz would include a smooth surface, as taught by Delk ‘037 and thus, the Velcro® strip 282 of Lutz in view of Delk ‘037 would not attach to itself. In conclusion, we find that the modification proposed by the Examiner of substituting the Velcro® strip 282 of Lutz with the strap portion 30 of Delk ‘037 would not have been obvious to the person of ordinary skill in the art.

For the above stated reasons, we conclude that the Examiner has not discharged the initial burden of establishing a *prima facie* case of obviousness of the subject matter of claims 1-6, 11-16, 20-23, and 31-37. Accordingly, the rejections of claims 1-6, 11-16, 20-23, and 31-37 under 35 U.S.C. § 103(a) as unpatentable over Lutz in view Delk ‘312 and further in view of Delk ‘037 and alternatively, over Lutz in view of Delk ‘037, are reversed.

NEW GROUNDS OF REJECTION

We make the following new grounds of rejection pursuant to 37 C.F.R. § 41.50(b).

Claims 1-6 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. Claim 1 recites a cable fastener including a variable-width opening, an elongated body having a predetermined width, and a head portion at one end of the body having “a size substantially similar to a size

of the variable-width opening” (underlining added). As far as we understand, the above mentioned limitations read on the Appellants’ tie wrap 504 (as shown in Figure 8 of the Appellants’ drawings) and which includes a body 802 (elongated body having a predetermined width), a head portion 804 that is wider than the body 802, and a variable-sized opening formed by the tie wrap 504 when the body 802 is pulled through the interior 806 of the handle portion 804 to form an encircling structure for a bundle of cables 902 (Spec. 8, ll. 13-20 and figs. 8 and 9 of the Appellants’ drawings). However, the limitation that the head portion has “a size substantially similar to a size of the variable-width opening” is indefinite because the size of the head portion is referenced to an object that is variable, that is, the variable-width opening which changes according to the number of enclosed cables. In light of the above, we conclude that claim 1, and claims 2-6 depending from claim 1, are indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point and distinctly claim the subject matter which the Appellants regard as the invention.

SUMMARY

The decision of the Examiner to reject claims 1-6, 11-16, 20-23, and 31-37 under 35 U.S.C. § 103(a) as unpatentable over Lutz in view of Delk ‘312 and further in view of Delk ‘037 is reversed.

The decision of the Examiner to reject claims 1-6, 11-16, 20-23, and 31-37 under 35 U.S.C. § 103(a) as unpatentable over Lutz in view of Delk ‘037 is reversed.

We enter new grounds of rejection of claims 1-6 under 35 U.S.C. § 112, second paragraph.

Appeal 2008-5180
Application 09/812,247

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED; 37 C.F.R. § 41.50(b)

vsh

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